

Patent Application No. 09/683,281

**REMARKS**

This Amendment is in response to the Final Office Action dated July 1, 2004. In the Office Action, claims 1-11 and 13-16 were rejected under 35 USC §103. By this Amendment, claims 1, 2, 5, 7, 10, 12, 13 and 15 are amended. Currently pending claims 1-15 and 17-19 are believed allowable, with claims 1, 5, 7, 10, 12, 13 and 15 being independent claims.

**CLAIM REJECTIONS UNDER 35 USC §103:**

Claims 1-8, 12 and 17-19 were rejected under 35 USC §103 as obvious over U.S. Patent No. 6,067,080 to Holtzman (hereinafter "Holtzman") in view of U.S. Patent No. 5,737,740 to Henderson et al. (hereinafter "Henderson") and U.S. Patent No. 5,599,122 to Yu (hereinafter "Yu"). Final Office Action, paragraph 5, page 2.

Claim 9 was rejected under 35 USC §103 as obvious over Holtzman in view of Henderson and in view of Yu, and further in view of U.S. Patent No. 3,819,857 to Inokuchi (hereinafter "Inokuchi"). Final Office Action, paragraph 17, page 6.

Claims 10, 11 and 13-15 were rejected under 35 USC §103 as obvious over Henderson in view of Holtzman and in view of Yu. Final Office Action, paragraph 20, page 6.

**I. ALL THE LIMITATIONS OF ARE NOT TAUGHT OR SUGGESTED BY THE CITED DOCUMENTS**

In rejecting claims under U.S.C. §103, the examiner bears the initial burden of establishing a *prima facie* case. MPEP 2142. To establish *prima facie* obviousness of a claimed invention, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142.

Claim 1 recites, in part, "a control circuit coupled to the ground detector, the control circuit configured to distinguish between each of the plurality of penpoints." Application, claim 1. Support for this claim element can be found at least at paragraph 41 of the Application. It is respectfully submitted that the limitations of this claim element are not found or suggested in the cited references.

Patent Application No. 09/683,281

Furthermore, claim 1 recites, in part, "a type recognition unit for recognizing the type of said penpoint selected by the selector." Application, claim 1. The claim further recites, "a selector for selecting a specific penpoint from said plurality of penpoints." Application, claim 1.

In rejecting claim 1, the Examiner concludes that Holtzman teaches a type recognition unit for recognizing the type of penpoint selected by the selector. Final Office Action, paragraph 6, page 2. The Examiner also concludes that Holtzman fails to teach a plurality of penpoints. Final Office Action, paragraph 6, page 2.

The Applicant respectfully submits that these two conclusions, that Holtzman teaches a type recognition unit recognizing a selected penpoint from multiple penpoints but does not teach multiple penpoints, are logically incongruous. Without a teaching of multiple penpoints, Holtzman could not possibly teach a type recognition unit for recognizing a specific penpoint selected from a plurality of penpoints.

The Final Office Action cites Holtzman at column 4, lines 55-60 as teaching a type recognition unit. Final Office Action, paragraph 6, page 2. However, the cited passage merely speaks to an encoding facility that "provides the ability to distinguish whether the writing implement is used for marking or as an erasing implement, as well as determining the nature or character of written line width or eraser swath." Holtzman at column 4, lines 55-60. It is respectfully submitted that the encoding facility of Holtzman does not teach or suggest a type recognition unit, recited in claim 1 of the pending application, for recognizing a specific penpoint selected from a plurality of penpoints.

Claim 5 recites, in part, "a control circuit coupled to the ground detector, the control circuit configured to distinguish between each of the plurality of penpoints." Application, claim 5. It is respectfully submitted that these limitations are not found or suggested in the cited references.

Claim 7 recites, in part, "a control circuit coupled to the ground detector, the control circuit configured to distinguish between each of the plurality of penpoints." Application, claim 7. It is respectfully

Patent Application No. 09/683,281

submitted that these limitations are not found or suggested in the cited references.

Claim 10 recites, in part, "a control circuit coupled to the ground detector, the control circuit configured to distinguish between each of the plurality of penpoints." Application, claim 10. It is respectfully submitted that these limitations are not found or suggested in the cited references.

Furthermore, claim 10 recites, in part, "an electromagnetic wave outputting unit for generating, to said digitizer, an electromagnetic wave of a different frequency for each penpoint selected by said penpoint selector." Application, claim 10.

In rejecting claim 10, the Examiner concludes that Holtzman teaches a frequency generator for generating a different frequency for each penpoint selected by a penpoint selector. Final Office Action, paragraph 21, page 7. The Examiner also concludes that Holtzman fails to teach a penpoint selector. Final Office Action, paragraph 21, page 7.

The Applicant respectfully submits that these two conclusions, that Holtzman teaches a frequency generator for generating a different frequency for each penpoint selected by a penpoint selector but does not teach a penpoint selector, are logically incongruous. Without a teaching a penpoint selector, Holtzman could not possibly teach a frequency generator for generating a different frequency for each penpoint selected by a penpoint selector but does not teach a penpoint selector.

Claim 12 recites, in part, "a pen including a plurality of penpoints and a control circuit configured to distinguish between each the plurality of penpoints." Application, claim 12. It is respectfully submitted that these limitations are not found or suggested in the cited references.

Claim 13 recites, in part, "changing, at a pen, an output frequency of a frequency generator based on a selected penpoint from a plurality of penpoints contained within the pen." Application, claim 13. It is respectfully submitted that these limitations are not found or suggested in the cited references.

Patent Application No. 09/683,281

Claim 15 recites, in part, "changing, at a pen, an output frequency of a frequency generator based on a selected penpoint from a plurality of penpoints contained within the pen." Application, claim 15. It is respectfully submitted that these limitations are not found or suggested in the cited references.

## II. YU IS NONANALOGOUS TO THE PRESENT APPLICATION

In order to rely on a reference as a basis for an obviousness rejection under U.S.C. §103, the reference must be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. MPEP 2141.01(a), quoting *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commanded itself to an inventor's attention in considering his problem. MPEP 2141.01(a), quoting *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

The field of the Applicant's endeavor is an electronic apparatus for sending input information written with a pen on a piece of paper placed on a digitizer to a computer system. Application, page 1, paragraph 2. On the other hand, the field of Yu is an ink cartridge selection mechanism of a multi-ink cartridge writing apparatus. Yu, column 1, lines 6-11. It is respectfully submitted that the field of the present Application is entirely different and nonanalogous to that of Yu.

Furthermore, the problem that the present invention is concerned with is electronically recording the same track simultaneously with the writing of a pen with a plurality of penpoints having different attributes such as color and thickness rather than only one type of penpoint. Application, page 2, paragraph 6. It is respectfully submitted that Yu's field of an ink cartridge selection mechanism cannot be characterized as reasonably pertinent to the problem of electronically recording the same track simultaneously with the writing of a pen with a plurality of penpoints having different attributes such as color and thickness rather than only one type of penpoint.

Patent Application No. 09/683,281

**III. THERE IS NO MOTIVATION FOR YU TO COMBINE WITH HOLTZMAN**

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP 2143. The tendency to resort to impermissible hindsight based upon the applicant's disclosure must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. MPEP 2143.

The Final Office Action states, "Although Yu deals with ink only pens and not digitizer pens, one of ordinary skill in the art at the time the invention was made would realize the effects of providing multiple penpoints with selection there between without having to change the position of the user's hand." Final Office Action, paragraph 30, page 10. Although the Office Action cites teaching in Yu that its subject ink cartridge selection mechanism can be used to select a desired ink cartridge for writing without changing the holding position of one's hand, no evidence is presented showing any suggestion or motivation to combine such teaching with that of Holtzman. Aside from the Examiner's unsupported assertions, the Applicant respectfully submits that nothing in the record provides any suggestion or motivation that one skilled in the art would combine the teachings of Yu with Holtzman.

**IV. DEPENDENT CLAIMS**

Claims 2-4 and 17 are dependent on and further limit claim 1. Since claim 1 is believed allowable for the above reasons, claims 2-4 and 17 are also believed allowable for at least the same reasons.

Claims 6 and 18 are dependent on and further limit claim 5. Since claim 5 is believed allowable for the above reasons, claims 6 and 18 are also believed allowable for at least the same reasons.

Claims 8, 9 and 19 are dependent on and further limit claim 7. Since claim 7 is believed allowable for the above reasons, claims 8, 9 and 19 are also believed allowable for at least the same reasons.

Patent Application No. 09/683,281

Claim 11 is dependent on and further limits claim 10. Since claim 10 is believed allowable for the above reasons, claim 11 is also believed allowable for at least the same reasons.

Claim 14 is dependent on and further limits claim 13. Since claim 13 is believed allowable for the above reasons, claim 14 is also believed allowable for at least the same reasons.

#### CONCLUSION

In view of the forgoing remarks, it is respectfully submitted that this case is now in condition for allowance and such action is respectfully requested. If any points remain at issue that the Examiner feels could best be resolved by a telephone interview, the Examiner is urged to contact the attorney below.

No fee is believed due with this Amendment, however, should a fee be required please charge Deposit Account 50-0510. Should any extensions of time be required, please consider this a petition thereof and charge Deposit Account 50-0510 the required fee.

Respectfully submitted,

  
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